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Robert Levin

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EXAMINER

COLLINS, DOLORES R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT LEVIN

Appeal 2009-011966
Application 10/787,486
Technology Center 3700

Before MICHAEL W. O'NEILL, KEN B. BARRETT, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown in the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Robert Levin (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 1 and 3. Appellant cancelled claim 2.² The Examiner withdrew claims 4-6 from consideration pursuant to a restriction requirement. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The claims on appeal relate to a vocabulary building method.

Claim 1, reproduced below with emphasis added, is representative of the subject matter on appeal.

1. An educational method for increasing a student's vocabulary comprising the steps of:
 - identifying a first expression consisting of a commonly known person, place, thing, event, title, phrase, or quote consisting of one or more words;
 - obscuring said words by substituting one or more of said words with lesser known words to form a second expression;
 - presenting the second expression to a student to decipher using his vocabulary knowledge of said lesser known words;
 - providing said student with one or more definitions of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression*
 - whereby said student learns the lesser known words and adds them to his vocabulary by actively using said definitions of the lesser known words in deciphering the second expression back into the first expression.

² In the revised Status of Claims section, filed November 18, 2008, Appellant lists claims 4-6 as being cancelled. However, a review of the record reveals that claims 4-6 were not cancelled by Appellant, but were instead withdrawn from consideration by the Examiner in the April 20, 2005 Office Action pursuant to a restriction requirement.

The Rejection

The following Examiner's rejection is before us for review:

Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alam (U.S. Patent No. 3,678,602, issued Jul. 25, 1972) in view of Mankoff (U.S. Patent No. 3,935,651, issued Feb. 3, 1976).

OPINION

Issue

The determinative issue in this appeal is:

Did the Examiner err in concluding that the combination of Alam and Mankoff renders obvious all of the steps of the method of claim 1? This issue turns on whether Mankoff teaches or suggests "the providing step."

Analysis

Appellant contends that the combination of Alam in view of Mankoff "does not arrive at [Appellant's] four-step process" because the resulting method from the combination of Alam in view of Mankoff leaves the student with nothing to decipher as is required by claim 1. App. Br. 22.

The Examiner's position is that Alam discloses the identifying, obscuring, and presenting steps of claim 1, but fails to disclose the providing step. Ans. 4. The Examiner posits that Mankoff discloses the providing step. *Id.* The Examiner concluded that it would have been obvious to one of ordinary skill in the art to combine Alam and Mankoff in order to provide a player with multiple choices. *Id.*

Alam discloses a vocabulary building card game having two or more decks of cards with each deck bearing cards having a word part such as prefix, root, or suffix thereon. Abstract, Figs. 1 and 3, and col. 2, ll. 26-29.

The reverse side of each card has a definition of the respective prefix, root, or suffix. Abstract. By learning what many prefixes, roots, and suffixes mean, one will automatically recognize the meaning of all words which are made up of a combination of one of those prefixes, roots, and suffixes. Col. 2, ll. 15-23.

Mankoff discloses a deck of cards similar to a conventional deck of playing cards. Abstract. As with a conventional deck of playing cards, each card in Mankoff's deck has one of four suits (i.e., hearts, diamonds, spades, and clubs). Col. 2, ll. 16-21. In contrast to a conventional deck of playing cards, each card in Mankoff's deck contains a vocabulary word thereon along with a value denomination for each of three multiple choices, one of the three multiple choices being the correct definition for the vocabulary word and the other two choices being incorrect definitions. Figs. 2-5 and col. 2, ll. 29-42. The value denomination of each card corresponds to that of the correct definition for the vocabulary word. Col. 2, ll. 29-42. Once the value denominations of the cards have been identified by selection of the correct definition of the vocabulary words, Mankoff's deck of cards can be used to play any standard card game. Col. 3, ll. 6-10.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988).

In the present case, the Examiner has not met the initial burden of establishing a prima facie case of obviousness because the Examiner has

failed to establish a factual basis to support the legal conclusion of obviousness. The Examiner has failed to establish that the combination of Alam and Mankoff discloses all of the steps of the method of claim 1. More particularly, the Examiner has failed to show that Mankoff discloses the step of providing the student with one or more definitions of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression.

Indeed, with respect to Mankoff, all the Examiner's rejection states is that "Mankoff discloses vocabulary playing cards . . . with words and definitions, which are used to decipher the vocabulary word (see abstract, claim 1 and col. 2, lines 29-68)." Ans. 5.

After reviewing Mankoff's disclosure and in particular, the sections of Mankoff particularly pointed to by the Examiner (i.e., the abstract, claim 1, and col. 2, lines 29-68), we do not find sufficient evidence within Mankoff which supports the Examiner's allegation that Mankoff discloses the step of providing the student with one or more definitions of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression. Rather, Mankoff merely discloses providing a single definition and two wrong answers for the lesser known words. The single definition does not serve as a clue and we agree with Appellant that there is nothing to decipher.

Absent a teaching or suggestion of the providing step, we constrained to conclude that the Examiner has not set forth a prima facie case of obviousness by the modification of Alam in view of Mankoff. Therefore, we do not sustain the Examiner's decision to reject of claims 1 and 3 under 35 U.S.C. § 103(a) as being obvious over Alam in view of Mankoff.

CONCLUSION

The Examiner's erred in finding that Mankoff cures the defects of Alam because Mankoff does not disclose the providing step.

DECISION

We reverse the Examiner's decision to reject claims 1 and 3 under 35 U.S.C. §103(a) as being obvious over Alam in view of Mankoff.

REVERSED

Klh

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